

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-29 remain in this application. The Examiner stated that claim 27 would be allowable if put into independent format. However, this has not been done because the rejection of the parent claim is contested.

The examiner objected to claims 1-11, 26-29, and 23 & 24 for various reasons. The claims have been amended, making the objections moot.

Claims 1-3, 5, 6, 12-13, 16, 19, 21, and 23-24 were rejected under 35 U.S.C. §102(b) as being anticipated by Gisby (U.S. 5,943,416). Claims 4, 7-11, 14-15, 17-18, 20, 22, 25 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gisby. For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites a system including an Interactive Voice Recognition (IVR) unit connected to a CATI unit, wherein “said CATI agent transfers said participant’s communication connection to said IVR unit only if the participant agrees to the transfer for conducting an automated survey utilizing a drill-down survey technique” such that “if the participant does not agree to said transfer, said agent manually surveys the participant using at least some of the same questions from said automated survey”. Thus, the system allows at least some of the *same* questions to be asked either manually or automatically. This allows the system to survey users that may not be comfortable with automated systems, but to also take advantage of a more economical automated process when the participant agrees.

All of the remaining independent claims also recited a system or method with limitations that provide for similar features, i.e., that the participant can refuse an automated survey but still get asked at least some of the same questions manually.

In contrast, although Gisby appears to teach starting a survey with manual questions, the reference appears to teach that subsequently, all participants are transferred to an automated survey for the actual survey questions (see col. 2, line 66 to col. 3, line1). The reference also appears to teach a survey with all manual, or some manual, and some automated, questions (see col. 2, line 65 to col. 3, line 3; see also col. 3, lines 22-31). However, applicant could find no teaching where the

participant was given an option to refuse to be transferred to the automated survey, but could instead continue with the survey in a manual fashion, but still get asked *similar or the same questions*.

In fact, the reference teaches away from the claimed feature, when it states that “callers who do not wish to participate [are routed] to agents based on non-survey routing” whereas “callers who do wish to participate are routed according to survey routing rules” (see col. 2, lines 54-62). There is no process disclosed to survey callers who *won’t* participate in an *automated* survey, but *will* participate in a *manual* survey. The reference also states that “if the caller indicates that he/she is not willing to do the survey, then the call is routed to a regular agent...that is not part of the survey agent population” (col. 6, lines 62-66)

Furthermore, although the reference teaches that calls are “routed to *either* IVR 61 *or* a live agent” if the caller agrees to participate in a survey (see col. 5, lines 23-27; emphasis added), there is no teaching that the choice of such a routing is based on whether the caller agrees to an automated survey and if not, can instead participate in a manual survey. Thus, although the reference teaches that surveys may be either manual or automated (see col. 7, lines 1-6), there is no teaching that such a choice is based on the user refusing an automated survey but participating, instead, with a manual one.

Accordingly, the claims are patentable over the reference for the above reasons.

A number of the claims also recited the use of an automated “drill-down” technique. The Examiner argues that such a technique is old and well-known. Applicant takes this to mean that the Examiner is effectively taking Official Notice of the feature. Taking “official notice” requires that facts outside of the record be capable of instant and unquestionable demonstration as being ‘well-known’ in the art (see MPEP §2144.03). However, it appears that the Examiner has attempted, but failed, to find a reference which teaches an automated “drill-down” technique. Hence, such a feature is not likely to be “notoriously well known” as required (*id.*). Accordingly, applicant hereby traverses the official notice and formally requests, as

required by the MPEP (*id.*), that the Examiner locate a reference in support of his position that such techniques are well-known in the art of automated surveys.

Consequently, applicant asserts that the Examiner's rejection of claims 4, 17, 18, 20, 22, and 25-26 based on the effective Official notice that is herein traversed, be withdrawn absent the Examiner finding a reference supporting the notoriously "well known" nature of the claimed feature.

Similarly, the Examiner appears to have taken Official Notice that the feature of processing and providing survey information to a consumer within 24 hours after conducting the survey. Applicant also traverses this taking of Official Notice and requests that the Examiner locate prior art showing such a feature. Absent such art, the Examiner should withdraw the rejection of claims 7-9 and 15.

Finally, the Examiner has not provided the proper motivation for rejecting claims 4, 7-11, 14-15, 17-18, 20, 22, 25 and 26 for obviousness. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The prior art must also suggest the desirability of the modifications (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*).

The Examiner has cited no art for any such suggestion or motivation to modify the base reference. Merely listing an advantage or benefit of the modification is not sufficient, as some rationale for making the modification must be found in the reference, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the modification (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole'

would have been obvious at that time to that person.” (MPEP §2142, emphasis added).


Instead, this appears to be a classic case of hindsight reasoning, as the Examiner is relying on the application itself to provide his stated motivations for modifying Gisby to include the missing features. Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32669.

Respectfully submitted,

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Dated: September 20, 2006

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